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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/407,278	09/29/1999	DWIGHT L. ENGWALL	96-234C	2554

7590 01/13/2003

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EXAMINER

STAICOVICI, STEFAN

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 01/13/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application N .

09/407,278

Applicant(s)

ENGWALL ET AL.

Examiner

Stefan Staicovici

Art Unit

1732

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 December 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 17, 18 and 28.

Claim(s) withdrawn from consideration: 29 and 32-35.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See attachment

ATTACHMENT TO ADVISORY ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on December 20, 2002 (paper No. 11) disclaiming the terminal portion of any patent granted on this application that would extend beyond the expiration date of US Patent No. 5,746,553 has been reviewed and is accepted. The terminal disclaimer has been recorded.

In view of the terminal disclaimer filed on December 20, 2002 the double patenting rejection of claims 17-18 and 28 has been withdrawn.

Response to Amendment

2. Applicants' After-Final amendment filed December 20, 2002 (Paper No. 10) will not be entered since the proposed amendments raise new issues that would require further consideration.

Specifically, Applicants' request to amend the priority of the instant application to a continuation-in-part application of US Serial No. 08/629,120, now US Patent No. 5,746,553, raises new issues that would require further consideration on the Examiner's part in determining patentability of the newly claimed subject matter incorporated into said instant application. For example, it should be noted that under 35 U.S.C. 120 the alleged continuation-in-part application must have been "filed before the patenting or abandonment of or termination of proceedings on the first application" (see MPEP §201.08). The instant case was filed on 09/29/1999, whereas US Patent No. 5,746,553 was patented on 05/05/1998. If the claimed subject matter of the instant

application is not supported under 35 U.S.C. 112 by the disclosure of US Patent No. 5,746,553, then the filing date of the instant application is 09/29/1999 for those claims and the co-pending requirement of 35 U.S.C. 120 has not been met.

Furthermore, it should be noted that upon amendment of the priority of the instant application to a continuation-in-part status, a supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

Therefore, the rejection of claims 17-18 and 28 under 35 U.S.C. 103 has been maintained.

Conclusion

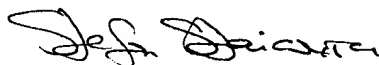
3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefan Staicovici, Ph.D. whose telephone number is (703) 305-0396. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM and alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard D. Crispino, can be reached at (703) 308-3853. The fax phone number for this Group is (703) 305-7718.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Stefan Staicovici, PhD



Primary Examiner

1/11/03

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January 11, 2003